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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. OLIVER, WILLIAM P. DENSMORE JR., and
MICHAEL J. CALLAHAN

Appeal 2009-005524
Application 09/036,236
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-88 which are all the claims pending in the application. Oral arguments were presented on May 6, 2010. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system for managing client accounts and controlling access to resources over data networks and for sharing client information and charges among a plurality of service providers (Spec. 4:11-13). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A system for managing client accounts and controlling access to resources over data networks, said system comprising:
 - (a) a mechanism for sharing client information and charges among a plurality of service providers;
 - (b) a client registration database maintained by one of the service providers (its "home provider") and includes information which selectively authorizes access to the resources of the other service providers ("outside providers"), each service provider maintaining an independent database of its respective clients;
 - (c) a settling means, separate from a respective home provider, for settling accounts among service providers by charging the home provider for access by its clients to the resources of the outside providers, the settling means accessing a respective home provider registration database, and communicating with an accounting database maintained separately from a respective registration database;
 - (d) a payment means adapted to assure that the outside providers

are then paid for that access;

(e) a sharing means adapted to allow the service providers to share users without requiring an open account for each user at each service provider; and

(f) a verification means including a token and an authentication server adapted to allow each service provider to determine if a particular client is registered by a home provider, verify that the client has authenticated at his home provider, and determine that client's access privileges and criteria.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Teper US 5,815,665 Sep. 29, 1998

Questions often asked by prospective Clickshare publishers;
Newshare Release; 1995. (Exhibit "L").

Clickshare(sm) alpha up; "test drives" available; Newshare Corp. Release; October 26, 1995. (Exhibit "O").

The following rejections are before us for review:

1. Claims 1-8, 11-25, 28-34, 63-64, 66-72, and 74-88¹ are rejected under 35 U.S.C. § 102(b) as anticipated by Clickshare Exhibit “O.”
2. Claims 9-10 and 26-27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Clickshare Exhibit “L.”
3. Claims 35-62 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Teper.

¹ The Examiners Answer does not list claims 83-88 in this cited rejection at page 18 of the Answer but does refer to these claims at page 23 of the Answer therefore these claims are considered to be rejected under this rationale as well.

4. Claims 65 and 73 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O,” Teper, and Clickshare Exhibit “L.”

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Exhibit “O” (Clickshare alpha up; “test drives” available) is enabled as a prior art reference and whether the argued claim limitations are provided by the cited reference.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Clickshare Exhibit “O” discloses that an alpha version is “up” (Title) and that alpha versions will be shipped “this week” (published Oct. 26, 1995). Exhibit “O” states that an initial base of Publishing Members will be launched in early 1996 and that point publishers will be able to see each others information. (Page 1).

FF2. Clickshare Exhibit “O” states in the “How It Works” section that: “Aggregate micro-charges, settled monthly or more frequently, allocating commissions, royalties and transaction fees, thus form the basis of a system resembling an ATM network.” (Page 4).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF3. Clickshare Exhibit “O” states in the “How It Works” section that: “A portion of all fees accumulated by a user for all visited Clickshare-enabled sites is retained by the user’s home Publishing Member. This is termed a “referral commission.” And Newshare retains a portion for its role in tracking and clearing transactions. At least 50 percent of each transaction goes to the content owner as a royalty.” (Page 4).

FF4. Clickshare Exhibit “O” states in the “How It Works” section that: “The second piece of essential software, the Clickshare token-validation service (TVS) server, is run by Newshare Corp. or licensees. It creates and validates authentication tokens, brokers non-personal user preferences among publishers, and maintains “page visit” records from multiple independent sites sortable by anonymous user number, page visited and site ID.” (Pages 2-3).

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Principles of Law Relating to Enablement of a Reference under Anticipation Rejection

“In order to anticipate, a prior art disclosure must also be enabling, such that one of ordinary skill in the art could practice the invention without undue experimentation. The standard for enablement of a prior art reference

for purposes of anticipation under section 102 differs from the enablement standard under 35 U.S.C. § 112.” *Novo Nordisk Pharm., Inc. v. Bio-Technology Gen. Corp.* 424 F.3d 1347, 1355 (Fed. Cir. 2005) (internal citations omitted.) While section 112 “provides that the specification must enable one skilled in the art to ‘use’ the invention,” *Id.* “section 102 makes no such requirement as to an anticipatory disclosure. Rather, anticipation only requires that those suggestions be enabled to one of skill in the art.” Whether a prior art reference is enabling is a question of law based upon the underlying factual findings.” *Id.* (internal citations omitted). Proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation. *Impax Labs. Inc. v. Aventis Pharm. Inc.*, 468 F.3d 1366, 1383. That is a section 102 prior art reference does not have to be “effective” to be enabling and thus anticipating. *Id.* Rather, the proper issue is whether the patent is enabling in the sense that it describes the claimed invention sufficiently to enable a person of ordinary skill in the art to carry out the invention. *Impax Labs* at 1383.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3)

the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art” *Id.* at 415-16.

ANALYSIS

Claims 1-8, 11-25, 28-34, 63-64, 66-72, and 74-88

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 102(b) is improper (Br. 37-45). The Appellants do not contest that Exhibit O describes the system that ultimately evolved into the claimed invention, but rather assert that Exhibit O is not enabling because: 1) it makes prophetic statements that are insufficient to permit persons of ordinary skill in the art to practice the invention (Br. 36) 2) that the Exhibit states that the product will be launched in 1996 which shows that these functions were unavailable at that time (Br. 37) and that, 3) the Declarations show that significant skill was required after the date to realize an operable version and that the invention was not reduced to practice (Br. 36-37) (See also Reply Br. 2-6). The Appellants further argue that Exhibit O does not disclose claim elements “c,” “d,” and “f” (Br. 43-45).

In contrast the Examiner has determined that Exhibit O discloses the claimed invention because Exhibit O teaches the features of the claimed elements “c,” “d,” and “f.” (Ans. 18-19).

We agree with the Examiner. The Appellants argue that Exhibit O is not a U.S. patent reference and that there is no presumption that the reference is operable and that it is the Examiner's burden to demonstrate that the reference is enabling (Br. 38). Initially, we note that prior art patents are presumed enabled as anticipatory art. *Amgen Inc. v. Hoechst Marion Rousel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003). As such, examiners are entitled to reject claims under § 102 over these references without inquiring whether their disclosures are enabled. *Id.* Rather, it is the Appellants' burden to show non-enablement of these references. *Id.* (citing *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980)). Here, the reference "Exhibit O" is not a prior art patent but instead a non-patent reference.

We acknowledge that there does not appear to be any binding precedent precisely on the issue of enablement under 35 U.S.C. § 102 for printed publications but in this case we see no reason why the same requirement should not be applied to the non-patent reference at issue. Indeed, while the Court in *Amgen* did not answer this issue, they did mention that our stance would be a logical extension. (See *Amgen*, 314 F.3d at 1355 n.22 "We note that by logical extension, our reasoning here might also apply to prior art printed publications as well, but as Sugitamo is a patent we need and do not so decide today.") Further, this Board has in fact decided cases where the presumption of enablement of anticipatory non-patent prior art references was at issue. See *Given Imaging, Ltd.* Appeal 2009-0649 at Concurrence 1-6 (BPAI, non-precedential); *Ex Parte Lu*, Appeal No. 2007-1893 at 4-7 (BPAI 2007, non-precedential); and *Ex Parte Swartzel* Appeal No. 1998-2941 at 20-21 (BPAI 1999, non-precedential). Thus, the burden of showing that Exhibit O as being a non-enabled non-patent reference in

this case is placed up on the Appellants. We also note that the portion of Exhibit O to which the Appellants specifically argue are non-enabled (claimed elements “c,” “d,” and “f”) appear to reference features that could be readily programmed by one of ordinary skill in the art further showing that burden of non-enablement should be placed on the Appellants in this case. The Appellants in the Appeal Brief at 36-42 fail to show that Exhibit O is non-enabled as it appears to involve only routine computer programming at the portions cited by the Appellants and the Appellants burden in this regard has not been met.

Apart from non-enablement, the Appellants also argue that Exhibit O does not disclose claimed element “c,” “d,” and “f” (Br. 43-45) from claim 1 which require:

(c) a settling means, separate from a respective home provider, for settling accounts among service providers by charging the home provider for access by its clients to the resources of the outside providers, the settling means accessing a respective home provider registration database, and communicating with an accounting database maintained separately from a respective registration database;

(d) a payment means adapted to assure that the outside providers are then paid for that access;

(f) a verification means including a token and an authentication server adapted to allow each service provider to determine if a particular client is registered by a home provider, verify that the client has authenticated at his home provider, and determine that client's access privileges and criteria. (Claim 1).

With regard to claimed element “c,” Clickshare Exhibit O states in the “How It Works” section that: “Aggregate micro-charges, settled monthly or more frequently, allocating commissions, royalties and transaction fees, thus form the basis of a system resembling an ATM network” (FF2) and we

determine that the claimed limitations for the “setting means” are disclosed by the citation to Exhibit O’s micro-charges being settled monthly and the allocating of commissions and royalties. The Clickshare Exhibit O settling system operates like an ATM network (FF2) and would inherently have to access a registration database (which would be identification based) of some kind in order to allocate commissions with a separate accounting database (which would be numerically based) of some kind.

With regard to claimed element “d,” Clickshare Exhibit O states in the “How It Works” section that: “A portion of all fees accumulated by a user for all visited Clickshare-enabled sites is retained by the user’s home Publishing Member. This is termed a “referral commission.” And Newshare retains a portion for its role in tracking and clearing transactions. At least 50 percent of each transaction goes to the content owner as a royalty” (FF3). We determine that the cited claimed limitation for the “payment means” are disclosed by Exhibits O’s citation to this tracking and clearing of transactions.

With regard to claimed element “f,” Clickshare Exhibit O states in the “How It Works” section that: “The second piece of essential software, the Clickshare token-validation service (TVS) server, is run by Newshare Corp. or licensees. It creates and validates authentication tokens, brokers non-personal user preferences among publishers, and maintains “page visit” records from multiple independent sites sortable by anonymous user number, page visited and site ID (FF4). We determine that the claimed limitation for the “verification means token” is disclosed by the citation to Exhibits O’s “authentication tokens.”

For these reasons we consider the Examiner to have established a prima facie case of anticipation. Given that a prima facie case of anticipation has been established for claim 1, we now turn to our consideration of the Declarations.

Specifically, the First Declaration of William Densmore, Jr. is directed to showing entitlement of the priority of invention with respect to U.S. Patent 5,815,665 and not related to the enablement of Exhibit O as a reference. Further, this Declaration provides insufficient evidence to show that Exhibit O would have failed to enable one of ordinary skill in the art with regards to the claimed elements “c,” “d,” and “f” of claim 1 based on its disclosure.

The Second Declaration of William Densmore, Jr. is also directed to showing entitlement of the priority of invention with respect to U.S. Patent 5,815,665. While the Second Declaration does state that Clickshare service was in an alpha test and that it was not offered for sale prior to March 7, 1996 (paragraphs 5 and 6) there is insufficient evidence to show that Exhibit O would have failed to enable one of ordinary skill in the art with regards to the claimed elements “c,” “d,” and “f” of claim 1 based on its disclosure.

The Third Declaration of William P. Densmore, Jr. discusses Exhibit O at paragraph 27, which then directs the discussion to paragraph 25 (where Exhibit M is discussed). The discussion here also provides insufficient evidence to show that Exhibit O would have failed to enable one of ordinary skill in the art with regards to the claimed elements “c,” “d,” and “f” of claim 1 based on its disclosure.

The Declaration of William Densmore, Jr., the Second Declaration of William Densmore, Jr., and the Third Declaration of William P. Densmore

Jr., have all been fully considered and all are also not deemed persuasive to show non-enablement of Exhibit O or a lack of anticipation for the argued cited claim limitations in this case. The cited Declarations fail to show that one of ordinary skill in the art, given the disclosure of the claimed elements “c,” “d,” and “f” would not have been enabled to make a respective described “settling means,” “payment means” and “verification token means” since each claimed element has been described and its implementation appears to only require what would be routine computer programming in the art which would not be out of the skill of one of ordinary skill in the art. The cited Declaration’s as a whole fails to show that Exhibit O is non-enabled or fails to anticipate the claim for the cited argued limitations.

For these above reasons, the rejection of claim 1 is sustained. With regards to the rejection of claims 2-8, 11-25, 28-34, 63-64, 66-72, and 74-88 under 35 U.S.C. § 102(b) the Appellants have provided essentially only the same arguments that have been addressed above. Note that a statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(o)(1) (2008). For the same reasons given above, the rejection of these claims is also sustained.

Claims 9-10 and 26-27

The Appellants at page 65 argues that the rejection of claims 9 and 26 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Clickshare Exhibit “L” is improper because the documents are “prophetic” (Br. 65-66) but provides no arguments beyond those addressed above, and for the same reasons given above, this argument is rejected.

The Appellants also argue that there is no evidence that the Clickshare Exhibit L was released in 1995 (Br. 65-66) but provide insufficient evidence to show this. Note that the Exhibit “L” bears a copyright date of 1995. The Appellants also state at page 65 that this date is not disputed by the Third Declaration of William Densmore, Jr. (Br. 65-66) and for these reasons, this argument is rejected as well.

For claims 9 and 26 the Appellants merely cite what each respective claim recites. Again, a statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(o)(1) 2008. For these reasons the rejection of claims 9 and 26 is sustained.

With regards to claims 10 and 27, the Examiner has acknowledged that neither Exhibit O nor Exhibit L teaches the use of a User Data Protocol to accomplish acceptance (Ans. 10-11) but has determined that which specific protocol to use would have been an obvious matter of protocol choice and we agree. The Appellants have argued that such a substitution would not have been obvious in a transactional environment but we disagree and see such a substitution as an obvious matter of protocol choice. For these reasons the rejection of claims 10 and 27 is also sustained.

Claims 35-62

With regard to the rejection of claim 35 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Teper the Appellants do not specifically argue for any specific claim limitations but assert that the Declaration of David M. Oliver, William P. Densmore, Jr. and Michael J. Callahan, and the Third Declaration of William P. Densmore Jr. were not

considered by the Examiner (Br. 67-69). The Appellants argue that the Advisory Action of February 4, 2005 did not check box 8 or 9 stating the Declaration was not entered (Br. 67-68, Reply Br. 7.)

In contrast, the Examiner states that the Declaration of David M. Oliver, William P. Densmore, Jr. and Michael J. Callahan was not timely presented (Ans. 26.) The Examiner notes that this Declaration was submitted after the Final Office Action of Sept. 2, 2004, was mailed and that it was not submitted with the request for continued examination (RCE) under 37 CFR § 1.114 and that the box (1. b.ii) for Affidavits/Declarations was not checked in that request (Ans. 26).

We have determined that it can not be ascertained that the Declaration of David M. Oliver, William P. Densmore, Jr. and Michael J. Callahan was ever officially entered into the case. While the Appellants are correct that the Advisory Action of February 4, 2005 did not have box 8 or 9 indicating that the Affidavit was not entered, it also did not have box 10 checked and which therefore did not state that Declaration was officially entered. Thus, to this point in the prosecution of the case, the Declaration cannot be deemed to have been officially entered into the case since automatic entry after a Final Rejection is not a matter of right. In the Applicants next response, a Request for Continued Examination (RCE) Transmittal was filed on March 2, 2005 and the proper box for consideration of the Declaration (Box 1a. (i. or ii) was not checked so there is no record that the cited Declaration was ever officially entered into the file for consideration. Further, we see no record of the Appellants addressing this Declaration whatsoever in the subsequent responses of Oct. 6, 2005 or Nov. 23, 2006 before the Appeal Brief was filed.

With regard to the Third Declaration of William P. Densmore Jr. filed October 6, 2005, the cited Declaration appears as admitted into the file record, and was not denied entry. While the Examiner did not comment on this Declaration, there is no evidence before us that this cited Declaration was not considered by the Examiner. Our consideration of the Third Declaration of William P. Densmore Jr. with regard to claims 35-62 is similar to that addressed above and the Declaration fails to show that non-enablement is present in Exhibit O here as well.

The Appellants have provided no separate arguments for claims 35-62 beyond merely reciting what the claims recite. Note that a statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(o)(1) (2008.)

As the record before us does not show that the Declaration of David M. Oliver, William P. Densmore, Jr. and Michael J. Callahan was officially entered into the file or that the Third Declaration of William P. Densmore Jr. was not considered by the Examiner, and since the Appellants have not argued for any specific limitations present in the claim, the rejection of claims 35-62 is sustained.

Claims 65 and 73

With regard to the rejection of claims the rejection of claims 65 and 73 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O,” Teper, and Clickshare Exhibit “L” provides arguments that have been addressed above. For the same reasons given above, the rejection of these claims is sustained.

The Appellants have provided no separate arguments for limitations in claims 65 and 73 beyond merely reciting what the claims recite. Note that a statement that merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(o)(1) (2008.)

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-8, 11-25, 28-34, 63-64, 66-72, and 74-88 under 35 U.S.C. § 102(b) as anticipated by Clickshare Exhibit “O.”

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 9-10 and 26-27 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Clickshare Exhibit “L.”

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 35-62 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O” and Teper.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 65 and 73 under 35 U.S.C. § 103(a) as unpatentable over Clickshare Exhibit “O,” Teper, and Clickshare Exhibit “L.”

DECISION

The Examiner’s rejection of claims 1-88 is sustained.

AFFIRMED

Appeal 2009-005524
Application 09/036,236

JRG

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